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In re Application of :
PROGULSKE-FOX *et al* :
U.S. Application No.: 09/980,845 :
PCT No.: PCT/US00/21340 :
Int. Filing Date: 04 August 2000 :
Priority Date: 06 August 1999 :
Attorney Docket No.: 00-505-B :
For: MICROBIAL POLYNUCLEOTIDES :
EXPRESSED DURING INFECTION OF :
A HOST :

DECISION

This is a decision on applicants' "Petition to Withdraw Holding of Abandonment under 37 CFR §1.181(A)" filed with the United States Designated/Elected Office (DO/EO/US) on 20 March 2006. No fee is required.

BACKGROUND

On 28 February 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that a copy of the sequence listing in computer readable form was required. A two-month time period for response was set with extensions of time available.

On 08 April 2002, applicant filed a response which included a paper copy of the sequence listing and a diskette containing the sequence listing. On 21 May 2002, the Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors in the sequence listing and sent an error report.

On 12 June 2002, a Notification of Defective Response" (Form PCT/DO/EO/916) was mailed indicating that a new CRF sequence listing diskette was required. Applicants were given one month to respond or any time remaining in the Form PCT/DO/EO/905 with extensions, whichever was longer.

On 01 July 2002, applicant submitted a response to the Form PCT/DO/EO/916 which included a paper copy of the sequence listing and a diskette containing the sequence listing.

On 03 January 2005, the DO/EO/US mailed a second Notification of Defective Response" (Form PCT/DO/EO/916) stating that a new CRF sequence listing diskette

was required. Applicants were given one month to respond or any time remaining in the Form PCT/DO/EO/905 with extensions, whichever was longer.

On 07 February 2005, applicants submitted a response to the Form PCT/DO/EO/916 including another paper copy of the sequence listing and a diskette containing the sequence listing.

On 03 March 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the Form PCT/DO/EO/905 mailed 28 February 2002 within the time period set therein.

On 20 March 2006, applicant filed the subject petition which was accompanied by, *inter alia*, 3 CD ROMs of the sequence listing.

On 22 March 2006, the STIC processed the CRF CD and found it acceptable.

DISCUSSION

Applicants' request reconsideration of the holding of abandonment because "the Applicants clearly responded in a timely manner to the notification of missing requirements mailed February 28, 2002." Applicants point to the fact that responses were submitted on 08 April 2002, 01 July 2002 and 07 February 2005.

A Form PCT/DO/EO/905 requesting a CRF sequence listing was mailed 28 February 2002 giving applicants two months to respond with extensions of time available pursuant to 37 CFR 1.136(a). As such, the time limit (with extensions) expired on 28 September 2002.

Applicants submitted a response containing the required CRF diskette on 08 April 2002. However, the CRF diskette was not accepted as it contained errors. A Form PCT/DO/EO/916 was mailed on 12 June 2002 requesting a new CRF diskette. A copy of the Raw Sequence Listing Error Report accompanied the notice. The Form PCT/DO/EO/916 gave applicants one month to respond (without paying an extension fee), or until 28 September 2002 (the time remaining in the Form PCT/DO/EO/905 mailed 28 February 2002 with extensions).

Applicants submitted a response on 01 July 2002 with a new CRF diskette. This CRF diskette was also found to be defective but no action was taken until 03 January 2005 when a second Form PCT/DO/EO/916 was mailed. Applicants' subsequent responses will not be discussed as they have no effect on the outcome of this decision.

The Form PCT/DO/EO/916 mailed 03 January 2005 was improper and is hereby

VACATED.

The above-captioned application was **ABANDONED** by operation of law on 28 September 2002. Applicants failed to provide a good CRF diskette as requested by the Form PCT/DO/EO/905. See 37 CFR 1.821(g).

There is no requirement for the DO/EO/US to notify applicants a second time prior to the expiration of the time remaining. The Form PCT/DO/EO/916 mailed 12 June 2002 provided the required notice. If applicants had any questions about the CRF diskette problems discussed in the Raw Sequence Error Report, applicants should have requested further clarification at that time.

DECISION

For the reasons discussed above, applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Applicants may also wish to consider to revive the above-captioned application pursuant to 37 CFR 1.137(a) or (b).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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